

**REMARKS/ARGUMENTS**

Applicant has studied the Office Action dated August 22, 2006 and has made amendments to the claims. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 1-24 are pending. Claims 1, 10, and 18 are amended. No new matter has been added. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

In the Office Action, the Examiner:

- (Page 2) accepted the previously submitted drawings amendments;
- (Pages 4-6) rejected claims 1, 6-7, 10-12, and 15 under 35 U.S.C. § 102(b) as being anticipated by Hoh et al. (U.S. Patent No. 4,232,068);
- (Page 6) rejected claims 1-2 and 9 under 35 U.S.C. § 102(b) as being anticipated by Colt (U.S. Patent No. 1,552,912);
- (Pages 6-7) rejected claims 18-19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Hoh et al. (U.S. Patent No. 4,232,068);
- (Pages 7-8) rejected claims 4, 8, 13, and 16 under 35 U.S.C. § 103(a) as being unpatentable over Hoh et al. (U.S. Patent No. 4,232,068) in view of Grove Products, Inc.;
- (Pages 8-9) rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Colt (U.S. Patent No. 1,552,912) in view of Hartin (DES 423,909);
- (Page 9) stated that claims 14 and 17 would be allowable if rewritten in independent form; and
- (Page 9) allowed claims 21-24.

(Page 9) Allowable Subject Matter

The Applicant wishes to thank Examiner Laux for indicating the allowable subject matter of claims 14 and 17 and the allowance of claims 21-24 in their current state.

Since claims 14 and 17 depend from newly amended claim 10, and dependent claims contain all the limitations of the independent claim from which it depends, Applicant has elected not to rewrite claims 14 and 17 in independent form and instead rely on the distinguishing features of the present invention, as recited in the new amendments, to overcome the Examiner's rejections in light of the cited art.

(Pages 4-6) Rejection under 35 U.S.C. §102(b), Hoh et al.

As noted above, the Examiner rejected claims 1, 6-7, 10-12, and 15 under 35 U.S.C. § 102(b) as being anticipated by Hoh et al. (U.S. Patent No. 4,232,068). Claims 1 and 10 have been amended to distinguish and to more clearly define the present invention over Hoh et al. Support for the changes is found on page 21 of the specification of the instant application. No new matter has been added.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Amended independent claim 1 recites, *inter alia*:

...  
a body formed with a first portion and a second portion; and  
a slot dividing the first portion of said body into a pair of **compressible** wave-shaped extending arms **that compress while being inserted into a gap defined by opposing surfaces and having a dimension smaller than a distance between a trough and a peak of the wave and thereby exerting outward pressure on the surfaces of the gap.** (emphasis added)

Amended claim 10 recites, *inter alia*:

...  
each with a first portion and a second portion and formed with a slot dividing the first portion into a pair of **compressible** wave-shaped extending arms **that compress while being inserted into a gap defined by opposing surfaces and having a dimension smaller**

**than a distance between a trough and a peak of the wave and thereby exerting outward pressure on the surfaces of the gap ...**  
(emphasis added)

The present invention is a shim for windows, doors, and other similar applications. The inventive shim provides **compressible** wave-shaped arms that allow it to secure itself in openings of various widths. Instant specification, para. 0049. The shim of the present invention has a body 10 that is divided into a first portion and a second portion. *Id.*, para. 0048. A slot 7 divides the first portion and defines the pair of **compressible** wave-shaped extending arms 8 and 9. *Id.*, para. 0048 and FIGs. 2A-5.

A side view of the shim 16, as shown in FIG. 2B, shows the wave shape, which has well defined peaks 12 and troughs 13 in the arms. See also, instant specification, para. 0048. As shown in FIG. 3 and described in the first paragraph of page 21 of the specification of the instant application, by inserting the shim with a distance between its peaks and troughs greater than the width of the gap, the shim will be in a compressed state once inside the gap and only the resulting positive outward pressure of the compressed shim 16 is necessary to hold the shim 16 in its inserted position.

Claims 1 and 10 have been amended to further clarify this distinguishing feature and now recite "compressible wave-shaped extending arms that compress while being inserted into a gap ... having a dimension smaller than a distance between a trough and a peak of the wave and thereby exerting outward pressure on the surfaces of the gap".

Hoh et al. discloses a shim with "longitudinal, parallel, narrow, grooves and ridges". Hoh et al., col. 3, lines 51-52. The grooves and ridges are present on the Hoh et al. shim only to "minimiz[e] any tendency of the stacked shims to shift **laterally** with respect to each other." Hoh et al., col. 3, lines 59-63. The lateral grooves and ridges are shown in FIGs. 1, 2, and 5 of Hoh et al. and run the entire length of the shim. These grooves and ridges are described by Hoh et al. as "striations" and **do not render**

the arms "wave-shaped" or "compressible". Because the arms are not wave-shaped, they do not have peaks and troughs.

However, even if the Examiner maintains that the grooves and ridges of Hoh et al. are wave shaped, and do have peaks and troughs, the grooves run long ways along the arms and would butt up against the edges defining a gap with a dimension smaller than a distance between a trough and a peak of the wave. Therefore the Hoh et al. shim would never fit inside the gap and obviously would not be able to exert outward pressure on the gap

Therefore, Hoh et al. do not disclose slot dividing the first portion of said body into a pair of compressible wave-shaped extending arms that compress while being inserted into a gap defined by opposing surfaces and having a dimension smaller than a distance between a trough and a peak of the wave and thereby exerting outward pressure on the surfaces of the gap, as recited in claims 1 and 10 of the instant application.

The Examiner cites 35 U.S.C. § 102(b) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims as being anticipated by Hoh et al.<sup>1</sup> Because the elements in independent claims 1 and 10 of the instant application are not taught or disclosed by Hoh et al., the shim of Hoh et al. does not anticipate the present invention. Dependent claims 2-9 and 11-20 are believed to be patentable as well because they all are ultimately dependent on either claim 1 or 10. Accordingly, the present invention distinguishes over Hoh et al. for at least this reason. The Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. § 102(b) has been overcome.

(Page 6) Rejection under 35 U.S.C. §102(b), Colt

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<sup>1</sup> See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

As noted above, the Examiner rejected claims 1-2 and 9 under 35 U.S.C. § 102(b) as being anticipated by Colt (U.S. Patent No. 1,552,912).

Amended claim 1 recites, *inter alia*:

a body...and...a slot dividing the first portion of said body into a pair of **compressible wave-shaped extending arms** that compress while being inserted into a gap defined by opposing surfaces and having a dimension smaller than a distance between a trough and a peak of the wave and thereby exerting outward pressure on the surfaces of the gap... (emphasis added)

The shim of the present invention has a body 10 that is divided into two portion with one portion having wave-shaped arms 8 and 9. Instant specification and FIG. 2A-5. The arms of the shim of the instant invention are **compressible**, which allows the arms to exert outward pressure on the gap.

Applicant again sets forth the argument that Colt discloses a solid **wedge-shaped shim and not a "wave-shaped" shim**. Compare Colt, FIG. 1 with FIG. 2b of the instant application. There is a well-recognized difference between a "wave" and a "wedge" in the English language. The Merriam-Webster online dictionary (<http://www.merriamwebster.com/dictionary>) defines a "wedge" as "a piece of a substance that tapers to a thin edge and is used for ...tightening by being driven into something", which exactly describes the Colt device. A "wave" on the other hand is defined as "to follow a curving line or take a wavy form : **UNDULATE**... to swing (something) back and forth or up and down...2 : to impart a curving or undulating shape to".

The arms of the shim in Colt continuously "taper." Colt, page 2, lines 1-4 and FIGs. 1-10. It is therefore submitted that the definition of a wave in no way applies to or describes the Colt shim.

In one embodiment of Colt, the shim is provided with what Colt itself describes as "**angularly shaped re-enforcing ribs 16**". Colt, page 2, lines 15-18. Therefore, the ribs 16 also fit the definition of wedge-shaped. Colt, FIG. 2. Therefore, the ribs 16 of

Colt, are not "wave-shaped". Furthermore, the tapered ribs 14 and 15 of Colt are on straight legs 12 and 13, which are solid. See FIGs. 1-10. **The legs 14 and 15 of Colt are solid and are not compressible.**

Colt clearly does not disclose a pair of wave-shaped arms, nor does Colt disclose "compressible" arms, as recited in claim 1 of the instant application.

The Examiner cites 35 U.S.C. § 102(b) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims as being anticipated.<sup>2</sup> Because the elements in independent claim 1 of the instant application are not taught or disclosed by Colt, the shim of Colt does not anticipate the present invention. Dependent claims 2-9 are believed to be patentable as well because they all are ultimately dependent on claim 1. Accordingly, the present invention distinguishes over Colt for at least this reason. The Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. § 102(b) has been overcome and that the Examiner should withdraw the rejection.

(Pages 6-7) Rejection under 35 U.S.C. §103(a), Hoh et al.

As noted above, the Examiner rejected claims 18-19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Hoh et al. (U.S. Patent No. 4,232,068)<sup>3</sup>. Independent claim 18 has been amended to distinguish and to more clearly define the present invention over Hoh et al. Support for the changes is found in the first paragraph of page 21 of the specification of the instant application. No new matter has been added.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

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<sup>2</sup> See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

<sup>3</sup> Applicants make no statement as to whether such a combination is even proper.

Amended independent claim 18 recites, *inter alia*:

...  
a slot dividing the first portion of the body into a pair of **compressible wave-shaped extending arms that compress while being inserted into a gap defined by opposing surfaces and having a dimension smaller than a distance between a trough and a peak of the wave and thereby exerting outward pressure on the surfaces of the gap.**

As stated in the section above, entitled "(Page 4) Rejection under 35 U.S.C. §102(b), Hoh et al.," Hoh et al. discloses a shim with "longitudinal, parallel, narrow, grooves and ridges". Hoh et al., col. 3, lines 51-52. The grooves and ridges are present on the Hoh et al. shim only to "minimiz[e] any tendency of the stacked shims to shift laterally with respect to each other." Hoh et al., col. 3, lines 59-63. The lateral grooves and ridges are shown in FIGs. 1, 2, and 5 of Hoh et al. and run the entire length of the shim. These grooves and ridges do not render the arms "wave-shaped", nor do they allow the shim to compress and "be inserted into a gap with a dimension smaller than a distance between a trough and a peak of the wave and exerting outward pressure on the gap" as recited in claim 18.

Therefore, Hoh et al. do not disclose a slot dividing the first portion of the body into a pair of compressible wave-shaped extending arms capable of being inserted into a gap with a dimension smaller than a distance between a trough and a peak of the wave and exerting outward pressure on the gap, as recited in claim 18 of the instant application.

It is accordingly believed to be clear that Hoh et al. neither shows nor suggests the features of claim 18. Claim 18 is, therefore, believed to be patentable over the cited art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 18.

(Page 7) Rejection under 35 U.S.C. §103(a), Hoh et al. in view of Grove Products

As noted above, the Examiner rejected claims 4, 8, 13, and 16 under 35 U.S.C. § 103(a) as being unpatentable over Hoh et al. (U.S. Patent No. 4,232,068) in view of

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Grove Products, Inc.<sup>4</sup>

The deficiencies of Hoh et al. are discussed above in the section entitled "(Page 4) Rejection under 35 U.S.C. §102(b), Hoh et al."

Grove Products Inc. manufactures a traditional shim that is a flat piece of material with a groove separating two arms. The Grove Products shim does not have "compressible wave shaped arms" that are capable of "exerting outward pressure on the gap."

When there is no suggestion or teaching in the prior art, the suggestion can not come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP § 2143 and Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and In re Fitch, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art reference Hoh et al. taken alone and/or in view of Grove Products, Inc. does not even suggest, teach or mention a wave-shaped body... a pair of wave-shaped extending arms, wherein a direction of the wave is away from the end, as recited in claims 1 and 10 of the instant application.

Accordingly, claims 1 and 10 distinguish over Hoh et al. taken alone and/or in view of Grove Products, Inc. Claims 4 and 8 depend from claim 1 and claims 13 and 16 depend from claim 10. Therefore, claims 4, 8, 13, and 16 are believed to be allowable as well.

For the foregoing reasons, independent claims 1 and 10, as amended, distinguish over Hoh et al. taken alone and/or in view of Grove Products, Inc. Claims 4 and 8 depend from independent claim 1 and claims 13 and 16 depend from independent claim 10. Since dependent claims contain all the limitations of the

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<sup>4</sup> Applicants make no statement as to whether such a combination is even proper.



independent claims, claims 4, 8, 13, and 16 distinguish over Hoh et al. taken alone and/or in view of Grove Products, Inc. as well, and the Examiner's rejection should be withdrawn.

(Page 8) Rejection under 35 U.S.C. §103(a), Colt in view of Hartin

As noted above, the Examiner rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Colt (U.S. Patent No. 1,552,912) in view of Hartin (DES 423909).<sup>5</sup>

In the section entitled "(Page 5) Rejection under 35 U.S.C. §102(b), Colt" above, the deficiencies of the prior-art shim disclosed in the Colt reference were discussed.

The Examiner cites Hartin. However, Hartin does not show, and the Examiner does not allege that it shows, the deficiencies of the Colt reference.

Claim 5 depends directly from newly amended claim 1. Independent claim 1 distinguishes over Colt in view of Hartin. Since dependent claims contain all the limitations of the independent claims, claim 5 distinguishes over Colt and Hartin, as well. The Applicant respectfully requests that the Examiner's rejection of claim 5 be withdrawn.

**CONCLUSION**

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Applicant acknowledges the continuing duty of candor and good faith to disclose information known to be material to the examination of this application. In accordance with 37 CFR § 1.56, all such information is dutifully made of record. The foreseeable

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equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicant and the attorneys.

The present application, after entry of this amendment, comprises twenty four (24) claims, including seven (7) independent claims. Applicant has previously paid for twenty four (24) claims including seven (7) independent claims. Applicant, therefore, believes that an additional fee for claims amendment is currently not due.

If the Examiner believes that there are any informalities that can be corrected by Examiner's amendment, or that in any way it would help expedite the prosecution of the patent application, a telephone call to the undersigned at (561) 989-9811 is respectfully solicited.

The Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account 50-1556.

In view of the preceding discussion, it is submitted that the claims are in condition for allowance. Reconsideration and re-examination is requested.

Respectfully submitted,

Date: October 23, 2006

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